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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,266	10/23/2003	Arthur R. Piehl	200312416-1	1571

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HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER	
MAHONEY, CHRISTOPHER E	
ART UNIT	**PAPER NUMBER**
2851	

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/692,266	PIEHL, ARTHUR R.	
	Examiner	Art Unit	
	Christopher E Mahoney	2851	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-42* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *23 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *10/23/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 contains the trademark/trade name Texas Red. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe an optical dye and, accordingly, the identification/description is indefinite.

The applicant is also requested to clarify the meaning of EYFP (perhaps enhanced yellow fluorescent protein) and to declare if EYFP, Sytox Blue and Alexa 633 are definite, determinable colors or if they are source identifiers (even if not trademarks).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 5-9, 11-13, 15-17, 19-24, 26-27, 29-32, 34-36, and 38-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Do (U.S. Patent No. 5,957,560). Do teaches a projection screen 24 comprising a substrate having thereon one or more fluorescent materials (col. 3. lines 41 and 51, col. 5, lines 30-45) that emit visible light in red (col. 5, lines 31-35), green (col. 5, lines 36-40), and blue (col. 5, lines 41-45) wavelengths, upon receiving incident thereon, light in the UV spectrum (col. 5, line 49). One or more absorption materials (metal or color plastic) absorb wavelengths of light that are not included in the one or more ranges and not included in the other range (col. 5, lines 62-67).

Claims 1-3, 5-9, 11-13, 15-17, 19-24, 26-27, 29-32, 34-36, and 38-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Friesem (U.S. Patent No. 3,881,800). Friesem teaches a projection screen 20 comprising a substrate 10 having thereon one or more fluorescent materials 12 (col. 1, lines 50-54, col. 2, lines3-4) that emit visible light in red, green, and blue wavelengths (figure 2, col. 2, lines 3-5), upon receiving incident thereon, light in the UV spectrum (col. 1, line 57). One or more absorption materials (col2, line 1) absorb wavelengths of light that are not included in the one or more ranges and not included in the other range. Primer dots 11 are disposed between the fluorescent material and the substrate to reflect light in the one or more ranges (col 2, lines15-19).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 4, 14, 18, 25, 28, 33, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Do (U.S. Patent No. 5,957,560) in view of Spector (U.S. Patent No. 4,323,301) or in view of Freese (U.S. Patent No. 6,816,306). Do teaches the salient features of the claimed invention except for a Lambertian distribution. Both Spector (col. 1, line 18) and Freese (col. 8, line 21) teach that it was known to produce a screen with Lambertian distribution. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the features taught by Spector or Frees for the purpose of providing uniform brightness or uniform viewing throughout any angle.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Do (U.S. Patent No. 5,957,560). Do teaches the salient features of the claimed invention except for the specific optical dyes. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize Texas Red, Sytox Blue, or Alexa 633, for the purpose of utilizing commercially available materials. The applicant should note that it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claim 4, 14, 18, 25, 28, 33, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friesem (U.S. Patent No. 3,881,800) in view of Spector (U.S. Patent No. 4,323,301) or in view of Freese (U.S. Patent No. 6,816,306). Friesem teaches the salient features of the claimed invention except for a Lambertian distribution. Both Spector (col. 1, line 18) and Freese (col. 8, line 21) teach that it was known to produce a screen with Lambertian distribution. It would have been obvious to one of ordinary skill in the art at the time the

invention was made to utilize the features taught by Spector or Frees for the purpose of providing uniform brightness or uniform viewing throughout any angle.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Friesem (U.S. Patent No. 3,881,800). Friesem teaches the salient features of the claimed invention except for the specific optical dyes. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize Texas Red, Sytox Blue, or Alexa 633, for the purpose of utilizing commercially available materials. The applicant should note that it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. The applicant is also directed to review col. 1, lines 47-60.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher E Mahoney whose telephone number is (571) 272-2122. The examiner can normally be reached on 8:30AM-5PM, Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on (571) 272-2258. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher E Mahoney
Primary Examiner
Art Unit 2851